

REMARKS

Claims 6-19 and 21-27 are pending. By this Amendment, claim 20 is cancelled, claims 6, 11, 13 and 17-19 are amended and new claims 21-27 are added.

Specification

The Office Action objected to the disclosure because in paragraph 27, the anterior surface and the retina were both referenced by reference numeral 6. By this Amendment, Applicant has amended paragraph 27 to correct the typographical error. Applicant respectfully requests that the Examiner withdraw the objection.

The Office Action also objected to the specification because the formulas from the background of the invention section need to be included in the U.S. specification. By this Amendment, Applicant has amended the specification to include the formulas which were inadvertently omitted from the application during the translation process. No new matter has been added because the formulas were fully disclosed in the international application to which this application claims priority. Applicant respectfully requests that the Examiner withdraw the objection.

Drawings

The Office Action objected to the drawings indicating that the subject matter of the application admitted to illustration by drawings and that no drawings were included. Applicant respectfully traverses the objection. The Examiner's attention is directed to the application as published by the U.S. Patent and Trademark Office which demonstrates that the drawings were in fact included in the publication and therefore must have been available to the Patent and Trademark Office. As such, the requirement for drawings has been met and Applicant

respectfully traverses the objection. Applicant respectfully requests that the Examiner withdraw the objection.

Claim Objections

The Office Action objected to claims 17, 19 and 20 under 37 C.F.R. 1.75 as being substantial duplicates of claims 10, 12 and 16 respectively. Applicant has amended claims 17 and 19 to correct typographical errors so that claims 17 and 19 depend from claim 15. Thus, claims 17 and 19 are no longer substantial duplicates of claims 10, 12. By this Amendment, Applicant has canceled claim 20. Applicant respectfully requests that the Examiner withdraw the objection.

35 U.S.C. § 101

The Office Action rejected claims 6-20 under 35 U.S.C. § 101 as being directed to non-statutory subject matter under *In Re Bilski*. By this Amendment, Applicant has amended independent claims 6 and 13 to recite “a method implemented by a measuring instrument”. Thus, claims 6 and 13 now meet the requirements of the machine or transformation test. Applicant respectfully requests that the Examiner withdraw the rejection.

35 U.S.C. § 112

The Office Action rejected claims 6-20 under 35 U.S.C. § 112, first paragraph, as being based on a disclosure which is not enabling. The support of this rejection in the Office Action cites *In Re Mayhew*. While not acquiescing to the rejection, Applicant has amended the specification to include the inadvertently omitted formulas, thus overcoming the rejection.

The Office Action further rejected claims 6-20 under 35 U.S.C. § 112, second paragraph, as being indefinite indicating “the phrase ‘to calculate intraocular lens’ need to be clarified to

what is meant, because intraocular lens calculations can encompass many variables. More specification is needed.” By this Amendment, the Applicant has amended claim 6 and 13 in response to the rejections. The Applicant respectfully traverses the rejection as the Specification fully supports the amended claims. As amended, claims 6 and 13 recite “to calculate the parameters of an optimally adapted intraocular lens.” The Specification recites that upon calculation of the optimal intraocular lens parameters, the appropriate lens may be selected from the intraocular lens manufacturer’s specifications. Specification, pg. 1, para. [0006]. While many variables may be involved in intraocular lens calculations, a person of ordinary skill in the art would recognize the necessary parameters that must be calculated to select the appropriate intraocular lens from the intraocular lens manufacturer’s specifications. Id. As such, the Applicant respectfully requests that the Examiner withdraw the rejections.

The Office Action further rejected claims 9-16 indicating that they recite the limitation “the measuring instrument” for which insufficient antecedent basis is found. As indicated above, claims 6 and 13 have been amended which provided antecedent basis for “the measuring instrument. Applicant respectfully requests that the Examiner withdraw the rejections.

The Office Action rejected claims 11-18, indicating the meaning of the phrase “comprises measuring to determine measured values and applying a correction value to the measured values” is unclear. By this Amendment, Applicant has amended claims 11 and 18 in response to the Examiner’s rejection. Applicant respectfully requests that the Examiner withdraw the rejection.

35 U.S.C. § 102

The Office Action rejected claim 6 under 35 U.S.C. § 102(a) as being anticipated by Rosa. Applicant respectfully traverses the rejection. Rosa uses an entirely different approach to the problem addressed by the current invention. The Rosa article suggests that an empirically found correlation between axially length and corneal radius correction factors to correct one of the IOL formulas. However, reference to the “Conclusion” section of the Abstract in Rosa, clearly explains that the method disclosed by Rosa is a *theoretical* method based on correlation between axial eye length and corneal radius correcting factors. Thus, the method of Rosa is purely theoretical and is not based on any physical measurement of the eye as is the presently claimed invention. As such, Rosa cannot anticipate or render obvious the presently pending claims. Applicant respectfully requests that the Examiner withdraw the rejection.

35 U.S.C. § 103

The Office Action rejected 7-20 as being unpatentable over Rosa under 35 U.S.C. § 103(a). Applicant respectfully traverses the rejection. First, as indicated above, Rosa does not disclose or suggest all the limitation of claim 6 and cannot anticipate the method of claim 13 which includes all the limitations of claim 6. Accordingly, Rosa cannot anticipate the method as recited in independent claim 13. Therefore, claims 7-12 and 14-20 are patentable at least by virtue of their dependency on claims 6 and 13 respectfully.

Further, the obviousness rejections over Rosa are perfunctory and concusory and do not meet the burden to establish a prima facie case of obviousness. The Office Action recites: “If the postoperative radius was measured after the refractive intervention, it would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify the method of

Rosa, to derive and obtain a first anterior and a first posterior corneal radius when the postoperative data is present in order to correlate the axial length for calculating the IOL power after surgery.” It is insufficient to merely state that the limitations of the claims are obvious. Rather, the analysis “should be made explicit.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (citing *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”)) Thus claims 7-20 are patentable for at least this additional reason. Applicant respectfully requests that the Examiner withdraw the rejection.

New Claims 21-27

New claims 21-27 recite the limitations that are not disclosed or suggested by the prior art of record in the application and should be allowable for the same reasons as claims 6-12.

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,

A handwritten signature in black ink, consisting of a stylized 'P' followed by several loops and a long horizontal stroke extending to the right.

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